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Docket No.: 1131-0544PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Shusei TAKANO et al.

Application No.: 10/551,644

Confirmation No.: 5443

Filed: September 29, 2005

Art Unit: 1731

For: NICOTINE INHALATION PIPE AND
NICOTINE HOLDER

Examiner: Not Yet Assigned

LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Information Disclosure Statement filed on September 29, 2005, attached hereto is an English translation of the International Preliminary Examination Report on Patentability (Chapter I) issued by the International Bureau of WIPO. The prior art references in the Examination Report were all previously cited on September 29, 2005. The attached translation is being filed for the Examiner's convenience, and fulfils the requirement for a concise explanation of the relevance of this non-English language document set forth in MPEP 609.04(a)(III).

It is respectfully requested that the Examiner initial the PTO/SB/08 form submitted with the Information Disclosure Statement on September 29, 2005 and return the same to the undersigned, to confirm his consideration of all documents cited therein.

No fee is required.

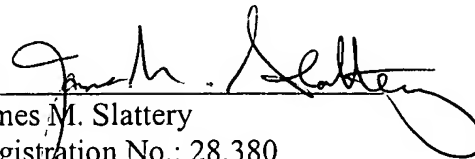
If the Examiner has any questions concerning this submission he/she is requested to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: July 5, 2006

Respectfully submitted,

By



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Attorney for Applicant

Attachment(s):

☐

PTO-SB08

☐

Documents

☐

Foreign Search Report

☐

Fee

☒

Other: English translation of the on of the International Preliminary Examination Report

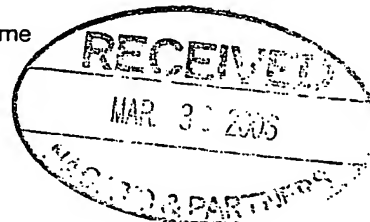
From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

To:

NAGATO, Kanji
5F, SKK Bldg.
8-1, Shinbashi 5-chome
Minato-ku
Tokyo, 1050004
JAPON



| | |
|--|--|
| Date of mailing (day/month/year) 09 March 2006 (09.03.2006) | |
| Applicant's or agent's file reference FPHH952PC | IMPORTANT NOTIFICATION |
| International application No. PCT/JP2004/004528 | International filing date (day/month/year) 30 March 2004 (30.03.2004) |
| Applicant TAKANO, Shusei et al | |

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

| | |
|---|--|
| The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland | Authorized officer Yoshiko Kuwahara |
| Facsimile No. +41 22 740 14 35 | Facsimile No. +41 22 338 90 90 |

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

| | | |
|--|---|---|
| Applicant's or agent's file reference FPHH952PC | FOR FURTHER ACTION | See item 4 below |
| International application No. PCT/JP2004/004528 | International filing date (<i>day/month/year</i>) 30 March 2004 (30.03.2004) | Priority date (<i>day/month/year</i>) 01 April 2003 (01.04.2003) |
| International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237 | | |
| Applicant TAKANO, Shusei | | |

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

| | |
|---|---|
| The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 740 14 35 | Date of issuance of this report 02 March 2006 (02.03.2006) Authorized officer <div style="text-align: center; font-weight: bold;">Yoshiko Kuwahara</div> Telephone No. +41 22 338 90 90 |
|---|---|

PATENT COOPERATION TREATY

Translation

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

FPHH952PC

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/JP2004/004528

International filing date (day/month/year)

30.03.2004

Priority date (day/month/year)

01.04.2003

International Patent Classification (IPC) or both national classification and IPC

Applicant

TAKANO, Shusei

1. This opinion contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the opinion |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/JP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/004528

Box No. 1

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/JP2004/004528

| Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement | | |
|--|--|-----------|-----|
| 1. Statement | | | |
| Novelty (N) | Claims | 2-7, 9-11 | YES |
| | Claims | 1, 8 | NO |
| Inventive step (IS) | Claims | | YES |
| | Claims | 1-11 | NO |
| Industrial applicability (IA) | Claims | 1-11 | YES |
| | Claims | | NO |
| 2. Citations and explanations: | | | |
| <p style="text-align: center;">The following documents are cited in the ISR:</p> <p>Document 1: JP, 2-171174, A (Buruga Zene AG Buruku), 2 July, 1990 (02.07.90)</p> <p>Document 2: JP, 2002-34547, A (Kenichi Mori, Riki Fujiwara), 5 February, 2002 (05.02.02)</p> <p>Document 3: JP, 11-164679, A (Japan Tobacco Inc.), 22 June, 1999 (22.06.99)</p> <p>Document 4: JP, 11-178562, A (Japan Tobacco Inc.), 6 July, 1999 (06.07.99)</p> <p>Document 5: Microfilm of the specification and drawings annexed to the written application of Japanese Utility Model Application No. 45621/1989 (Laid-open No. 138597/1990), (Japan Pionics Co., Ltd.), 19 November, 1990 (19.11.90)</p> <p>Document 6: Microfilm of the specification and drawings annexed to the written application of Japanese Utility Model Application No. 63491/1986 (Laid-open No. 175896/1987), (Earth Chemical Co., Ltd.), 9 November, 1987 (09.11.87)</p> <p>Claim 1</p> <p>It is considered that document 1 contains (a) a carrier structure that corresponds to a liquid-absorbing body impregnated with a nicotine preparation, (b) a nicotine suction path in the axial direction of a casing, and (c) a mouth piece shown in the drawings. Accordingly, the subject matter of claim 1 does not appear to be novel or to involve an inventive step in view of document 1.</p> <p>Claim 2</p> <p>A member that corresponds to an inner tube provided with a narrow hole is recognized in Fig. 6 of document 2. Accordingly, the subject matter of claim 2 does not appear to involve an inventive step in view of documents 1 and 2.</p> <p>Claim 3</p> <p>Fig. 3 of document 3 shows a molded body 32 that is a carrier of a material to be sucked, is in a cylindrical form, and has a plurality of passages in the axial direction. Accordingly, the subject matter of claim 3 does not appear to involve an inventive step in view of documents 1 and 3.</p> <p>Claim 4</p> <p>It is considered that, in Fig. 2 of document 4, there is a passage in the axial direction between the outer face of a bar 8, which is a carrier of a material to be sucked, and an outer wrapper. Accordingly, the subject matter of claim 4 does not appear to involve an inventive step in view of documents 1, 3 and 4.</p> <p>Claim 5</p> <p>Document 5 (see the specification, page 3, line 19 through page 4, line 4) shows a feature</p> | | | |

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/004528

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

wherein a carrier of a material to be sucked is formed of porous particles. Accordingly, the subject matter of claim 5 does not appear to involve an inventive step in view of documents 1 and 5.

Claim 6

Document 6 (see the specification, page 9, line 19, etc.) shows a feature wherein silica gel is adopted as a carrier. Accordingly, the subject matter of claim 6 does not appear to involve an inventive step in view of documents 1, 5 and 6.

Claim 7

Document 7 (see paragraph [0043]) suggests a feature wherein a suction-tool main body 1 that corresponds to an outer tube is made of a transparent resin. Accordingly, the subject matter of claim 7 does not appear to involve an inventive step in view of documents 1, 2, 5 and 6.

Claim 8

The subject matter of claim 8 does not appear to be novel or to involve an inventive step in view of document 1 for the same reason as described for claim 1 above.

Claim 9

The subject matter of claim 9 does not appear to involve an inventive step in view of documents 1 and 5 for the same reason as described for claim 5 above.

Claim 10

The subject matter of claim 10 does not appear to involve an inventive step in view of documents 1, 5 and 6 for the same reason as described for claim 6 above.

Claim 11

The subject matter of claim 11 does not appear to involve an inventive step in view of documents 1, 2, 5 and 6 for the same reason as described for claim 7 above.